

REMARKS/ARGUMENTS

Claims 1-34 are pending in the present application. In the Office Action, claims 4, 14 and 21-34 were withdrawn and claims 1-3, 5-13 and 15-20 were rejected. In response to the Office Action, claims 9, 11 and 20 have been amended and claims 21-34 have been cancelled. No new matter has been added. Reexamination and reconsideration of the pending claims is respectfully requested.

Specification

The Examiner requested several corrections to the specification. On page 7, line 9, the Examiner indicated that "and" should be inserted between "withdrawn" and "part." The sentence currently recites "In some embodiments, the shuttle is positioned outside the expandable member and a sheath, such that when the sheath is withdrawn part of the expandable member is exposed to expand against the shuttle, thus expanding and deploying one or more stent segments." Applicants believe amending the specification as suggested would be grammatically incorrect in the context of the entire sentence. However, in order to clarify the specification, the sentence has been amended to recite "In some embodiments, the shuttle is positioned outside the expandable member and a sheath, such that when the sheath is withdrawn, part of the expandable member is exposed to expand against the shuttle, thus expanding and deploying one or more stent segments."

In line 23 of page 9, reference number "25b" has been amended to recited "25a" and the status of U.S. Patent Application No. 10/412,714 has been updated in line 7, page 2; line 2, page 3; line 18, page 9; and line 12, page 13. Additionally, as suggested by the Examiner, the term "stent pushing member" has been amended to recite "stent-pushing member" in line 31, page 4; line 22, page 5; line 15, page 7; line 29, page 9, lines 4-5, page 13; line 18, page 13; and line 3, page 14.

Claim Objections

In claims 9, 11 and 20, the term "stent pushing member" has been amended to recite "stent-pushing member" as suggested by the Examiner.

Double Patenting

Claims 1-2 and 5-8 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 22 of U.S. Patent No. 7,192,440. Claim 3 was rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over U.S. Patent No. 7,192,440 in view of Shakhovich (U.S. Patent No. 5,807,398). Claims 9-12 and 15-20 were rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over U.S. Patent No. 7,147,655 in view of Chermoni (U.S. Patent No. 7,147,655) and Acosta et al. (U.S. Patent No. 7,147,655). Without conceding the issue of patentability and in order to expedite prosecution, Applicants submit herewith a Terminal Disclaimer thereby obviating the rejection.

Claim Rejections - 35 U.S.C. § 103

Claims 1-2, 5-12 and 15-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chermoni, U.S. Patent Publication No. 2002/0156496 (hereinafter referred to as Chermoni) in view of Acosta et al., U.S. Patent No. 7,137,993 (hereinafter referred to as Acosta). Such rejection is overcome for at least the following reasons.

Acosta was filed on April 10, 2003, less than 1 year before the October 14, 2003 filing date of the present application. Therefore, Acosta can only be considered a 35 U.S.C. § 102(e) reference against the instant application. However, under 35 U.S.C. § 103(c)(1), subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of 35 U.S.C. § 102, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. The cited Acosta reference was assigned to Xtent, Inc. at the time the claimed invention was made and Xtent, Inc. is the assignee of the present invention. Therefore, under 35 U.S.C. §

Appl. No. 10/686,507
Amdt. dated December 6, 2007
Reply to Office Action of October 25, 2007

PATENT

103(c)(1), Acosta should be removed as prior art, obviating the 35 U.S.C. § 103(a) rejection. Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1-2, 5-12 and 15-20, and allowance thereof.

Claims 3 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chermoni in view of Acosta and further in view of Shaknovich, U.S. Patent No. 5,807,398 (hereinafter referred to as Shaknovich). Such rejection is overcome for at least the following reasons.

As discussed above, Applicants respectfully request that Acosta be removed as a reference under 35 U.S.C. § 103(c)(1) thereby obviating the rejection. Applicants also respectfully request the withdrawal of the 35 U.S.C. § 103(a) rejection of claims 3 and 13 and allowance thereof.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,


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Attachments
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